



A-28-04

1636  
JFW

Attorney Docket No. 1418.03

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: John Manfredi	)	Group Art Unit: 1636
Serial No.: US 10/040,969	)	
Filed: January 4, 2002	)	
Title: METHOD OF DETECTING	)	Examiner: Celine Qian
PROTEIN-PROTEIN INTERACTIONS	)	

April 26, 2004

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**RESPONSE TO RESTRICTION REQUIREMENT**

In response to the Restriction Requirement mailed March 24, 2004, Applicants elect, with traverse, Group I (Claims 1-12 and 23).

A proper requirement for restriction between inventions requires: (A) the inventions be independent or distinct as claimed; and (B) there is a serious burden on the examiner. *See* MPEP 803, 8<sup>th</sup> Edition, Revised February 2003, page 800-4. The Restriction Requirement alleges that Groups I-V are distinct because the inventions are drawn to methods that require different starting material and modes of operation. The Restriction Requirement alleges that each Group has acquired a separate status in the art, as shown by their different classification, and there is a serious burden on the examiner to examine Groups I-V together because each Group requires a search that is not co-extensive with the other Groups.

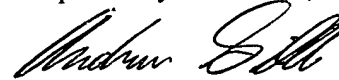
Applicants traverse the Restriction Requirement on two grounds. First, Applicants traverse the restriction between Groups I-IV on the basis that there is not a serious burden on the examiner to examine Groups I-IV together. A careful reading of the claims of Groups I-IV reveals that all the claims of Groups I-IV (Claims 1-33) are directed towards a method of using inteins to detect interaction of agents. Consequently, a search for the use of inteins to detect interaction is required for each claim in the application, irrespective of whether the different claims would be distinctly patentable over each other. Therefore, a search for the use of inteins to detect interaction would

suffice for all the claims in the application. As required by MPEP §803.01, “[i]f the search and examination of the entire application can be made without serious burden, the examiner **must examine** it on the merits, even though it includes claims to independent or distinct inventions.” See MPEP 803, 8<sup>th</sup> Edition, August, 2001, page 800-4 (emphasis added). Thus, there is no serious burden to examine Groups I-IV together and Applicants respectfully request that the Restriction Requirement be withdrawn in this respect.

Second, Applicants traverse the restriction of Groups I and IV on the ground that the classification of Groups I and IV is in error and thus the Restriction Requirement has not met the required burden of providing reasons or examples to support the conclusion that Groups I-IV are independent or distinct. Group I (Claims 1-12 and 23) is classified in class 435, subclass 320.1, which is drawn to a vector, per se. A careful reading of Claims 1-12 and 23 reveals that Claims 1-12 and 23 are not drawn to a vector, per se, but rather are drawn to a method of using inteins to detect interaction. Group IV (Claims 22 and 33) is classified in class 435, subclass 325, which is drawn to an animal cell, per se. A careful reading of Claims 22 and 33 reveals that Claims 22 and 33 are not drawn to an animal cell per se, but rather are drawn to a method of using inteins to detect interaction. Therefore, Applicants traverse the Restriction Requirement for Groups I and IV on the ground that the classification of Groups I and IV is in error and the Restriction Requirement has not met the required burden of providing reasons or examples to support the restriction of Groups I, III, and V. Thus, Applicants request that the restriction of Groups I and IV be withdrawn in and Groups I and IV be examined together with Group II or III.

For the reasons set forth above, Applicants traverse the Restriction Requirement and request that Groups I-IV (Claims 1-33) be examined together. It is not believed that any extension of time, or any fee is required in connection with this communication. However, if an extension of time (and extension fee) or other fees are required, such an extension of time is hereby petitioned for and the Commissioner is authorized to charge any fees or credit any overpayment to Deposit Account No. **50-1627**.

Respectfully submitted,



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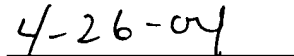
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Date of Deposit: April 26, 2004

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Michael Moreno



Date

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